



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,820	10/08/2008	Lyian He	60224US	7416
23430	7590	04/06/2011	EXAMINER	
GEORGE A LEONE, SR CITADEL PATENT LAW 9124 Gravelly Lake Drive SW SUITE 102 Lakewood, WA 98499			SISSON, BRADLEY L	
			ART UNIT	PAPER NUMBER
			1634	
			NOTIFICATION DATE	DELIVERY MODE
			04/06/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

george.leone@citadelpatentlaw.com
marissa.leone@citadelpatentlaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/582,820	HE ET AL.	
	Examiner	Art Unit	
	Bradley L. Sisson	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/2010 & 01/13/2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Drafts, Person's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 January 2011 has been entered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings were received on 28 May 2010. These drawings are acceptable.

Claim Objections

4. Claims 5-7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As a result of amendment, claim 1 now recites in step (a) that the detection probe consists essentially of "metal nanorod." The limitation of claim 5 that 'the

Art Unit: 1634

detection probe comprises a metal nanorod" does not further limit claim 1 from which it depends. Claims 6 and 7, which depend from claim 5, fail to overcome this issue and are similarly objected.

5. Claim 6 is also objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In accordance with claim 1, the "motor induced movement of the molecular motor serves to detect the target nucleic acid." To have dependent claim 6 recite that detection is achieved by "dark field microscopy" serves to broaden, not further limit claim 1 from which claim depends.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Attention is directed to MPEP 2111.03 [R-3], which states in part:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)... See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) ("Although consisting essentially of" is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method.

Art Unit: 1634

9. Claim 1 has been amended so to recite the clause "consisting essentially of" has been inserted to modify "a metal nanorod" (step (a)) and "a molecular motor." The "molecular motor" and "metal nanorod" are considered to be compounds, not compositions. Accordingly, it is not clear as to how the metal nanorod and molecular motor could be modified and not affect their basic and novel characteristics as such would result in a different compound. Claims 2-7, which depend from claim 1, fail to overcome this issue and are similarly rejected.

10. Claim 3 has been amended so to recite "the molecular motor consists essentially of F1-ATPase." The molecular motor has been construed as being a compound, not a composition. It is not clear how the enzyme, F1-ATPase, can be modified and not modify its basic and novel characteristics.

11. The term "regularly changing" in claim 1 is a relative term which renders the claim indefinite. The term "regularly changing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 2-7, which depend from claim 1, fail to overcome this issue and are similarly rejected.

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

Art Unit: 1634

the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

14. Attention is directed to MPEP 904.01.

The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do not call for, as well as what they do require. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 2111 - § 2116.01 for case law pertinent to claim analysis.

15. It is noted with particularity that narrowing limitations found in the specification cannot be inferred in the claims where the elements not set forth in the claims are linchpin of patentability. In *re Philips Industries v. State Stove & Mfg. Co, Inc.*, 186 USPQ 458 (CA6 1975). While the claims are to be interpreted in light of the specification, it does not follow that limitations from the specification may be read into the claims. On the contrary, claims must be interpreted as broadly as their terms reasonably allow. See *Ex parte Oetiker*, 23 USPQ2d 1641 (BPAI, 1992).

16. Claim 1 is the sole independent claim pending and as such, claims 2-7, which depend therefrom, comprise all limitations recited therein.

17. Step (f) of claim 1 reads:

(f) detecting movement of the molecular motor through the detection probe regularly changing color, wherein the motor induced movement of the molecular motor serves to detect the target nucleic acid in the sample, and where observation of ATP- dependent rotation of different colored nanorods indicates the presence of a corresponding target nucleic acid each having its unique probe attachment or different motors causing different specific motor-induced motion so as to allow determination of an assortment of different target nucleic acid(s) is/are present in any given sample (Emphasis added)

18. It is noted that a “molecular motor,” much less “movement” of same, does not “detect” anything. Rather, the observation of a molecular motor’s “movement” may be used to deduce

Art Unit: 1634

the presence of the target nucleic acid. Accordingly, the method, as presently claimed, cannot be practiced.

19. It is further noted that step (f) recites “observation of ATP-dependent rotation,” however, there is no requirement that any “ATP-dependent rotation” be observed. Accordingly, the recited clause is deemed to be expositive.

20. For the above reasons, and in the absence of convincing evidence to the contrary, claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Conclusion

21. Objections and/or rejections which appeared in the prior Office action and which have not been repeated hereinabove have been withdrawn.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571)272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Dave T. Nguyen can be reached on (571) 272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1634

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley L. Sisson/
Primary Examiner, Art Unit 1634